

REMARKS

By this amendment, claims 1, 10-12, and 15 are revised and claims 2, 6, and 13 are canceled. The subject matter of claims 2 and 6 is incorporated into claim 1 so as to place this application in condition for allowance. Claim 13 is canceled based on the cancellation of claim 2 and minor corrections are made to claims 10-12 and 15. Currently, claims 1, 3-5, 7-12, 14, and 15 are before the Examiner for consideration on their merits.

First, corrected drawings are submitted herewith in response to the objection made in the Office Action.

Second, Applicants traverse the rejection based on the revisions to claim 1. The rejection of claim 1 based on United States Patent No. 6,877,122 to Whetsel et al. (Whetsel) under 35 U.S.C. § 102(b) is no longer valid since claim 1 is revised to include the limitations of claim 6 therein. Consequently, the only pertinent rejection now is the rejection based on Whetsel and 35 U.S.C. § 103(a) against claim 6. In addressing the limitations of claim 6, the Examiner takes the position that it would be obvious to integrate the features of Whetsel into a communication network that would include the features found in claim 6, i.e., a test bus connected to the testing means and a proxy agent connected to the test bus and to the communication network. The reasoning for alleging that the combination of the features of claim 6 with Whetsel is because "it would broaden the application of Whetsel's core wrapper."

The question of obviousness is not to integrate the core wrapper taught by Whetsel into a communication network having the feature such as remote control, TAM, PA, SNMP, TCP/IP as a matter of application. Instead, the question of obviousness is whether the specific features of claim 1 are taught by Whetsel and

whatever common knowledge the Examiner appears to be citing. While the Examiner seems to be taking judicial notice of common knowledge of the art, there is no mention of any other prior art to support the rejection.

Applicants content that the Examiner has committed error by failing to provide adequate reasoning to conclude that the features of claim 1, as amended, is somehow obvious under 35 U.S.C. § 103(a). The general nature of the rejection is insufficient to establish a *prima facie* case of obviousness, which is incumbent on the Examiner to do prior to making Applicants traverse the rejection.

First, it is clear that Whetsel and the other prior art cited as part of the Office Action does not propose to use an existing communication network to implement test functionalities of IP cores in an SoC. None of the cited prior art teaches or suggests the implementation of an hybrid P1500/SNMP DFT SoC architecture like the one of the integrated chip of claim 1, as amended, to provide enhanced integrated chips with improved testing capabilities in a communication network.

As mentioned in page 3 of the description, the invention enhances the accessibility and testability to IP cores embedded in the SoC environment. According to the invention, P1500 standard is made compliant with SNMP protocols, which is considered to be beyond the classical network management framework because it is implemented directly within an SoC and not between individual communication stations or devices in a communication network. This means that a reduction in manufacturing testing costs can be realized. In addition, fault diagnostic is improved by collecting intend dates of IP cores using basic SNMP statistics.

All of the advantages identified above are not conceivable to the artisan familiar with data management at the time that the invention was made as P1500/SNMP had never been implemented at an SoC level prior to the invention.

Thus, even for one familiar with SNMP protocols and network management, it would not have been obvious to apply such technology at a far lower level of integration, i.e., at the SoC level.

To reiterate, the reasoning used in the rejection, i.e., broaden the application of Whetsel's core wrapper is insufficient to support the allegation of obviousness. The Supreme Court in the *KSR* decision requires articulated reasoning to support a rejection based on 35 U.S.C. § 103(a). This reasoning has not been set forth in the rejection and because of this, the rejection is improper and must be withdrawn. Again, claim 1, as amended, recites a specific arrangement of the functional or IP cores, and the communication means as a test bus and proxy agent. Claim 1 also defines the arrangement of the test bus, proxy agent, and testing means. In alleging that claim 6 is obvious, the Examiner has not identified how the core wrapper of Whetsel would be used such that all of the features of claim 6 would be present. Therefore, a *prima facie* case of obviousness is not established and the rejection as made must be either withdrawn or remade with the proper foundation. The Examiner is called upon to provide an objective factual basis to support any further allegation that claim 1 is obvious.

If the Examiner is somehow referring to common knowledge in the art to support the rejection, it is error for the Examiner to do this without substantiating such an allegation. Without any basis to support such a contention, the Examiner cannot conclude that the invention is obvious; a factual basis to support this conclusion is missing.

Further, since the revision to the claims only involves the incorporation of dependent claim subject matter into independent claim 1, any further rejection of claim 1 must be a non-final rejection.

To summarize, the Examiner has failed to establish a *prima facie* case of obviousness against the subject matter of claims 1, 2, and 6. This failure is based on the lack of any factual basis to conclude that Whetsel can be modified to produce the invention of claim 1. Since a *prima facie* case of obviousness is not established against claim 1, its dependent claims are also in condition for allowance.

Accordingly, the Examiner is respectfully requested to examine this application and pass all pending claims onto issuance.

If the Examiner believes that an interview would be helpful in expediting the allowance of this application, the Examiner is requested to telephone the undersigned at 202-835-1753.

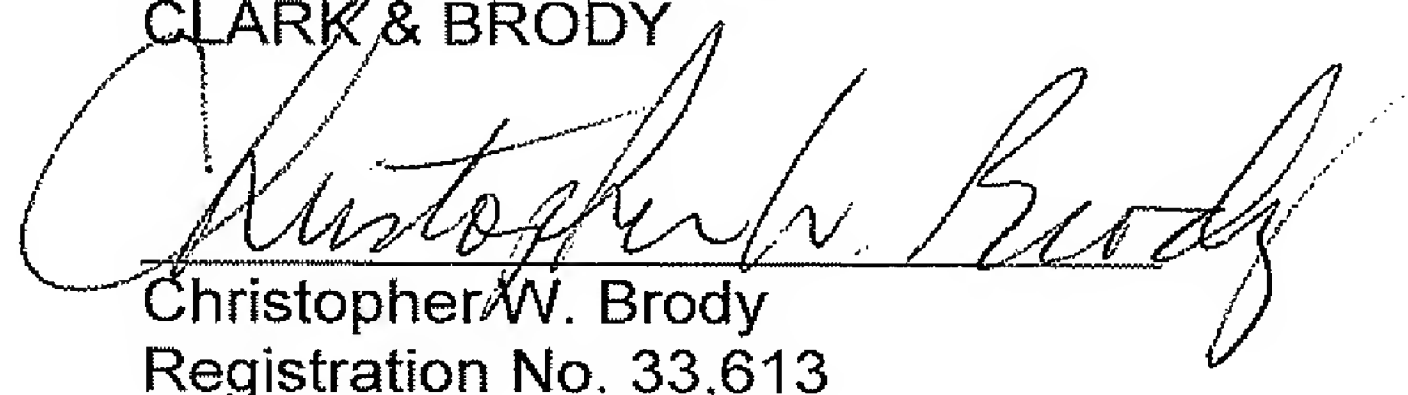
The above constitutes a complete response to all issues raised in the Office Action dated August 4, 2009.

Again, reconsideration and allowance of this application is respectfully requested.

Applicants respectfully petition for a one month extension of time. Please charge Deposit Account No. 50-1088 the petition fee of \$65.00.

Please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,
CLARK & BRODY

A handwritten signature in black ink, appearing to read "Christopher W. Brody", is written over a horizontal line. The signature is fluid and cursive.

Christopher W. Brody
Registration No. 33,613

Customer No. 22902
1090 Vermont Avenue, NW, Suite 250
Washington, DC 20005
Telephone: 202-835-1111
Facsimile: 202-835-1755
Docket No.: 71247-0063
Date: December 4, 2009